

REMARKS

Claims 1, 2, 4-9, 11-13 and 15-32 are pending in this application. By this Amendment, claims 1, 2, 4, 13, 15, 22 and 27 are amended to address claim objections.

No new matter is added to the application by this Amendment.

Reconsideration of the application is respectfully requested.

I. Claim Objections

Claims 1, 2, 4, 13, 15, 22 and 27 were for alleged informalities. This rejection is respectfully traversed.

In view of amended claims 1, 2, 4, 13, 15, 22 and 27, these claim objections are moot.

Thus, Applicants respectfully request withdrawal of the claim objections.

II. Rejection Under 35 USC 102

Claims 1, 2, 5-9, 11-13, 15-17 and 19-31 were rejected under 35 USC 102(b) as allegedly being anticipated by JP 09-286958 to Azuma et al. (hereinafter "Azuma").

Applicants respectfully traverse this rejection.

Prior to discussing the relative merits of the Examiner's rejection, the applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was

invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

The Patent Office alleges that Azuma discloses each and every feature recited in claims 1, 2, 5-9, 11-13, 15-17 and 19-31. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Present claim 1 specifically requires that the adhesive comprises the flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive. Thus, the entire presently claimed content

range for the flame retardant is at least 25% and no greater than 60% by weight of the adhesive as recited in claim 1.

Nowhere does Azuma disclose the entire presently claimed content range for the present flame retardant as required by claim 1. The Patent Office alleges that the abstract of Azuma discloses the presently claimed content range for the present flame retardant because Azuma's abstract discloses a composition having 100 pbw of acrylic based polymer and 5-70 pbw of ammonium polyphosphate (flame retardant), a nitrogen containing compound and a metallic oxide (see page 3 of the April 20, 2009 Office Action).

Contrary to the Patent Office's allegations, the passage (i.e., the abstract of Amuza) cited by the Patent Office does not disclose the entire claimed content range for the present flame retardant which is specifically defined in claim 1. Amuza's abstract discloses a content range of 5-70 pbw for three components (i.e., ammonium polyphosphate, a nitrogen containing compound and a metallic oxide) and not a sole component, such as, ammonium polyphosphate. However, even if the content range disclosed in Amuza's abstract solely included ammonium polyphosphate, Amuza's content range of 5-70 pbw for ammonium polyphosphate and 100 pbw for acrylic based polymer still fails to disclose the entire presently claimed content range for the present flame retardant as required by claim 1.

Instead, when Azuma's content range for ammonium polyphosphate is, for example, 5 pbw with 100 pbw of acrylic based polymer, the content of ammonium polyphosphate is about 4% by weight of the composition. Moreover, when Azuma's content range for ammonium polyphosphate is, for example, 70 pbw with 100 pbw of

acrylic based polymer, the content of ammonium polyphosphate is about 41% by weight of the composition. So, at best, Azuma's abstract discloses a composition that may have an ammonium polyphosphate content range of about 4% to about 41% by weight of the composition. Accordingly, Applicants submit that Azuma's ammonium polyphosphate content range of about 4% to about 41% by weight of the composition is not a concrete example of anticipation of the presently claimed adhesive comprising flame retardant component present in an amount of at least 25% and no greater than 60% by weight of the adhesive as required by claim 1.

Additionally, paragraph [0023] of Azuma discloses a composition having 100 pbw (i.e., weight section) of copolymer and 5-50 pbw of phosphorus compound which calculates to a phosphorus compound content of about 4.7% to about 33.3% by weight of the composition. Moreover, in paragraph [0028] of Azuma, a composition is disclosed having 5-70 pbw of polyphosphoric acid ammonium and 100 pbw of copolymer which calculates to a phosphorus compound content of about 4.7% to about 41.2% by weight of the composition.

Accordingly, Applicants submit that Azuma's ammonium polyphosphate content ranges of about 4% to about 41%, about 4.7% to about 33.3% and about 4.7% to 41.2% by weight of the composition are not concrete examples that anticipate the entire presently claimed adhesive having a flame retardant component in an amount of at least 25% and no greater than 60% by weight of the adhesive as required by claim 1. Thus, Azuma fails to anticipate the entire presently claimed range for the present flame retardant as required by claim 1.

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

Applicants further submit that Azuma discloses that resins may be present in the composition. And if resins are present in the composition, the amount of ammonium polyphosphate present in the composition would further be decreased based on the amount of resins present in the composition.

Because the features of independent claims 1 and 22 are neither taught nor suggested by Azuma, Azuma cannot anticipate, and would not have rendered obvious, the features specifically defined in claims 1 and 22 and their dependent claims.

For at least these reasons, claims 1, 2, 5-9, 11-13, 15-17 and 19-31 are patentably distinct from and/or non-obvious in view of Azuma. Reconsideration and withdrawal of the rejection of the claims under 35 USC 102(b) are respectfully requested.

III. Rejections Under 35 USC 103

A. Azuma in view of Boyce et al. or Parsons et al.

Claims 4, 18 and 32 were rejected under 35 USC 103(a) as allegedly being unpatentable over Azuma in view of EP 0 018 643 to Boyce et al. (hereinafter "Boyce") or US 5,851,663 to Parsons et al. (hereinafter "Parsons"). This rejection is respectfully traversed.

Boyce and/or Parsons do not remedy the deficiencies of Azuma as set forth above with respect to independent claims 1 and 22, from which claims 4, 18 and 32 directly or indirectly depend. Boyce and/or Parsons fail to remedy the deficiencies of Azuma because Boyce and/or Parsons also fails to teach a pressure sensitive adhesive having a flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive.

Thus, Azuma, Boyce and Parsons, taken singly or in combination, fail to teach or suggest a pressure-sensitive adhesive having a flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive as required by claims 1 and 22.

Because the features of independent claims 1 and 22 are neither taught nor suggested by Azuma, Boyce and Parsons, taken singly or in combination, these references would not have rendered obvious to one of ordinary skill in the art, the features specifically defined in claims 1 and 22 and their dependent claims.

For at least these reasons, claims 4, 18 and 32 are patentable over Azuma in view of Boyce or Parsons. Thus, withdrawal of the rejection under 35 USC 103(a) is respectfully requested.

B. Parsons

Claims 1, 2, 4-8, 11-13, 15, 18-29, 31 and 32 were rejected under 35 USC 103(a) as allegedly being unpatentable over Parsons. This rejection is respectfully traversed.

The Patent Office alleges that the foregoing claims would have been obvious to a skilled artisan in view of the teachings of Parsons. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

The Patent Office cites claims 1, 4 and 5 of Parsons and several passages of Parsons as allegedly teaching the presently claimed adhesive and P-40 flame retardant at a content range of 30-50 phr. Parsons' Example 24 specifically teaches P-40 flame retardant at a content range of 30-50 phr.

However, the amount of 30 - 50 % (phr) for P-40 in Example 24 is without a basis for this value been defined by the teachings of Parsons. In other words, it is not clear if (phr) is referring to weight-%, parts of weight (based on more than 100 parts) or if something completely different is meant to be defined by (phr). Because the basis for (phr) is not clear from Parsons' disclosure, a skilled artisan would not understand the concentration of P-40 disclosed in Parsons.

Moreover, because the basis for (phr) is not clear from Parsons' disclosure or would not be clear to a skilled artisan, the Parson's range of 30 – 50 % (phr) is not comparable to the presently claimed amount (for the flame retardant component) of at least 25% and no greater than 60% by weight of the adhesive. In other words, Parsons' range of 30 phr to 50 phr is not comparable because it is unclear if Parsons' range is based on the polyacrylic compound, the polyacrylic compound with resins, or one of these components together with the P-40 flame retardant itself. The same could be

said for Parsons' claim 1 having a range of 10 to 60 % because it is unclear according to Parsons' if that range is defined based on the weight of the adhesive, however, no disclosure, in Parsons, can be found if the resins are already considered or not.

Applicants submit that Parsons fails to teach or suggest a pressure-sensitive adhesive having a flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive as required by claims 1 and 22

Because these features of independent claims 1 and 22 are not taught or suggested by Parsons, this reference would not have rendered the features of claims 1, 9 and 12 obvious to one of ordinary skill in the art.

For at least these reasons, claims 1, 2, 4-8, 11-13, 15, 18-29, 31 and 32 are patentable over Parsons. Thus, withdrawal of the rejection under 35 USC 103(a) is respectfully requested.

C. Parsons in view of Sakurai

Claim 9 was rejected under 35 USC 103(a) as allegedly being unpatentable over Parsons in view of US Patent No. 6,893,583 to Sakurai. This rejection is respectfully traversed.

Sakurai does not remedy the deficiencies of Parsons as set forth above with respect to independent claims 1, from which claim 9 depends, because Sakurai also fails to teach or suggest a flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive.

Accordingly, Parsons and Sakurai, taken singly or in combination, fail to teach or suggest a pressure-sensitive adhesive having a flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive as required by claim 1.

Because the features of independent claim 1 are neither taught nor suggested by Parsons and Sakurai, taken singly or in combination, these references would not have rendered obvious to one of ordinary skill in the art, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claim 9 is patentable over Parsons and Sakurai. Thus, withdrawal of the rejection under 35 USC 103(a) is respectfully requested.

D. Parsons in view of Everaerts

Claim 9 was rejected under 35 USC 103(a) as allegedly being unpatentable over Parsons in view of US Patent No. 5,648,425 to Everaerts. This rejection is respectfully traversed.

Everaerts does not remedy the deficiencies of Parsons as set forth above with respect to independent claims 1, from which claim 9 depends, because Everaerts also fails to teach or suggest a flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive.

Accordingly, Parsons and Everaerts, taken singly or in combination, fail to teach or suggest a pressure-sensitive adhesive having a flame retardant component in an amount of at least 25% by weight of the adhesive and no greater than 60% by weight of the adhesive as required by claim 1.

Because the features of independent claim 1 are neither taught nor suggested by Parsons and Everaerts, taken singly or in combination, these references would not have rendered obvious to one of ordinary skill in the art, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claim 9 is patentable over Parsons and Everaerts. Thus, withdrawal of the rejection under 35 USC 103(a) is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2, 4-9, 11-13 and 15-32 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,
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